

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#3

In re Patent Application of:
Hamed Aissaoui et al.

Application No.: Not Yet Assigned

Confirmation No.: N/A

Filed: Concurrently Herewith

Art Unit: N/A

For: 1-PYRIDIN-4-YL-UREA DERIVATIVES

Examiner: Not Yet Assigned

INFORMATION DISCLOSURE STATEMENT (IDS)

MS PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 CFR 1.56, 1.97 and 1.98, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO/SB/08. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

For the Examiner's convenience, the references cited are included in PDF format on the enclosed CD Rom. The attached SB-08 form lists the file name for each document on the CD Rom. If the Examiner has any questions, he is welcome to contact the undersigned at the number below.

Timing of Filing of the Information Disclosure Statement:

☒ This IDS is being filed before the First Office Action¹.

¹ The IDS should, where possible, include a certification under 37 C.F.R. §1.97(e).

- ☐ This IDS is being filed after the issuance of the First Office Action but before the issuance of a Final Office Action².
- ☐ This IDS is being filed after the submission of a Notice of Appeal, but before the payment of the Final Fee³.

Certifications:

If checked, the undersigned makes the following statement(s):

- ☐ Statement under 37 CFR § 1.97(e):

Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement; or

No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

- ☐ Statement Under 37 C.F.R. § 1.704(d):

Each item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart application less than thirty days prior to the filing of this information disclosure statement.

² The IDS *must* include *either* a certification under 37 C.F.R. §1.97(e) *or* the fee set forth in 37 C.F.R. §1.17(p).

³ The IDS *must* include *both* a certification under 37 C.F.R. §1.97(e) *and* the fee set forth in 37 C.F.R. §1.17(p).

Fee Required by 37 C.F.R. § 1.97(c)(2) or 1.97(d)(2):

☐ If checked, the fee of \$180.00 set forth in 37 C.F.R. §1.17(p) is attached.

Copies of Information:

In accordance with 37 C.F.R. §1.98(a), the following are enclosed:

- ☒ An electronic copy⁴ of each document (or relevant portion thereof) cited in the attached PTO/SB/08 is included on the enclosed CD Rom in PDF format.
- ☒ With respect to any information which is not in English, a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, is attached. This concise explanation is provided by way of:

☐ A translation of the relevant portions of the non-English language information⁵;

☐ A statement explaining the relevant portions of the non-English language information;

⁴ A legible copy of the document is not required if (1) the information was previously cited by, or submitted to, the Office and considered by the Office in a prior U.S. application to which this application claims priority, provided that the prior application is properly identified in this IDS, and (2) the IDS submitted in the earlier application complies with 37 C.F.R. § 1.98(a) – (c). This exception does not apply to information cited in an International Application.

⁵ 37 C.F.R. §1.98(a)(3)(ii) *requires* that an English language translation be provided when a translation of the document, or portion thereof, “is within the possession, custody or control of, or is readily available to any individual designated in 37 C.F.R. § 1.56(c).”

☒ A copy [and, where not in the English language, a translation] of at least the relevant portion(s)⁶ of the communication from a foreign patent office in a counterpart foreign application in which the information was cited; or

☒ This information is contained in the specification of the present application.

☐ In accordance with 37 C.F.R. 1.98(d), copies of the cited documents are not enclosed as they were provided in application Serial No. _____, filed on _____, which the present application relies upon for an earlier effective filing date under 35 U.S.C. 120.

Materiality:

Whether or not the information and references disclosed in this Information Disclosure Statement is “material” pursuant to 37 CFR 1.56, this submission is not intended to constitute an admission that any patent, publication or other information referred to therein is “prior art” for this invention unless specifically designated as such.

In accordance with 37 CFR 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR 1.56(a) exists.

It is submitted that the Information Disclosure Statement is in compliance with 37 CFR 1.98 and the Examiner is respectfully requested to consider the listed references.

⁶ The relevant portion is that portion which indicates the degree of relevance found by the foreign patent office. This may be an explanation of which portion of the of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report. MPEP §609 III A(3).

Application No.: Not Assigned

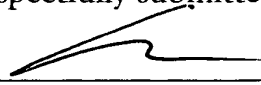
10/528043

Docket No.: A0345.0008
DT15 Rec'd PCT/PTO 11 7 MAR 2005

In the event the actual fee is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account No. 50-2215.

Dated: March 17, 2005

Respectfully submitted,

By 

Charles E. Miller

Registration No.: 24,576

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Attorney for Applicant

CEM/IY/da

Substitute for form 1449A/B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				Complete if Known	
				Application Number	Not Yet Assigned 10/528043
				Filing Date	Concurrently Herewith
				First Named Inventor	Hamed Aissaoui
				Art Unit	N/A
				Examiner Name	Not Yet Assigned
Sheet	1	of	4	Attorney Docket Number	A0345.0008

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				
	BA	EP-EP 0 428 434-A2	11-06-1990	SANOFI SA	Filename: EP0428434A2.pdf. Cited in the specification on page 4.	
	BB	WO-00/047577-A1	08-17-2000	SMITHKLINE BEECHAM PLC	Filename: WO00047577A1.p df. Cited in the ISR.	
	BC	WO-01/009088-A1	02-08-2001	KIRIN BEER KABUSHIKI KAISHA	Filename: WO01009088A1.p df. Cited in the specification on page 4.	
	BD	WO-01/045694-A1	06-28-2001	SMITHKLINE BEECHAM CORPORATION	Filename: WO01045694A1.p df. Cited in the specification on page 3.	
	BE	WO-01/045700-A1	06-28-2001	SMITHKLINE BEECHAM CORPORATION	Filename: WO01045700A1.p df. Cited in the specification on page 3.	
	BF	WO-01/045711-A1	06-28-2001	SMITHKLINE BEECHAM CORPORATION	Filename: WO01045711A1.p df. Cited in the specification on page 3.	
	BG	WO-01/066143-A1	09-13-2001	TAKEDA CHEMICAL INDUSTRIES LTD	Filename: WO01066143A1.p df. Cited in the specification on page 3.	<input checked="" type="checkbox"/>
	BH	WO-02/000606-A1	01-03-2002	TAKEDA CHEMICAL INDUSTRIES LTD	Filename: WO02000606A1.p df. Cited in the specification on page 3.	<input checked="" type="checkbox"/>

Examiner Signature		Date Considered	
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Substitute for form 1449A/B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				Complete if Known	
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				First Named Inventor	Hamed Aissaoui
				Art Unit	N/A
				Examiner Name	Not Yet Assigned
Sheet	2	of	4	Attorney Docket Number	A0345.0008

	BI	WO-02/002530-A1	01-10-2002	TAKEDA CHEMICAL INDUSTRIES LTD	Filename: WO02002530A1.p df. Cited in the specification on page 4.	<input checked="" type="checkbox"/>
	BJ	WO-02/047456-A2	06-20-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02047456A2.p df. Cited in the specification on page 3.	
	BK	WO-02/047687-A1	06-20-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02047687A1.p df. Cited in the specification on page 3.	
	BL	WO-02/058702-A1	08-01-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02058702A1.p df. Cited in the specification on page 3.	
	BM	WO-02/076979-A1	10-03-2002	ACTELION PHARMACEUTICALS LTD., ET AL.	Filename: WO02076979A1.p df. Cited in the ISR.	
	BN	WO-02/078641-A2	10-10-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02078641A2.p df. Cited in the specification on page 3.	
	BO	WO-02/078707-A1	10-10-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02078707A1.p df. Cited in the specification on page 3.	
	BP	WO-02/079155-A1	10-10-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02079155A1.p df. Cited in the specification on page 3.	
	BQ	WO-02/079188-A1	10-10-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02079188A1.p df. Cited in the specification on page 3.	
	BR	WO-02/089740-A2	11-14-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02089740A2.p df. Cited in the specification on page 3.	

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				First Named Inventor	Hamed Aissaoui
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Sheet	3	of	4	Attorney Docket Number	A0345.0008

	BS	WO-02/089785-A1	11-14-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02089785A1.p df. Cited in the specification on page 3.
	BT	WO-02/089792-A1	11-14-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02089792A1.p df. Cited in the specification on page 3.
	BU	WO-02/089793-A1	11-14-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02089793A1.p df. Cited in the specification on page 3.
	BV	WO-02/090337-A1	11-14-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02090337A1.p df. Cited in the specification on page 3.
	BW	WO-02/090348-A1	10-10-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02090348A1.p df. Cited in the specification on page 3.
	BX	WO-02/090353-A1	11-14-2002	SMITHKLINE BEECHAM CORPORATION	Filename: WO02090353A1.p df. Cited in the specification on page 3.
	BY	WO-03/048154-A1	06-12-2003	ACTELION PHARMACEUTICALS LTD.	Filename: WO03048154A1.p df. Cited in the ISR.
	BZ	WO-99/009024	02-25-1999	SMITHKLINE BEECHAM PLC	Filename: WO99009024A1.p df. Cited in the ISR.
	BA1	WO-99/021835	05-06-1999	FUJISAWA PHARMACEUTICAL CO., LTD.	Filename: WO99021835A1.p df. Cited in the ISR and the specification on page 4.

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
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				Art Unit	N/A
				Examiner Name	Not Yet Assigned
				Attorney Docket Number	A0345.0008
Sheet	4	of	4		

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	CA	Roderick A. Porter, et al.; "1,3-Biarylureas as selective non-peptide antagonists of the orexin-1 receptor"; BIOORGANIC & MEDICINAL CHEMISTRY LETTERS; Vol. 11; 2001; pp. 1907 - 1910; Filename: "Porter - Selected Non-Peptide Antagonists.pdf"	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

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